

REMARKS

Summary of the Office Action

Claims 81-180 are currently pending in this application. Claims 156-180 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 156-180 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 81-84, 86, 88-109, 111, 113-134, 136, 138-159, 161 and 163-180 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schein et al. U.S. Patent No. 6,002,394 ("Schein") in view of Venkatraman et al. U.S. Patent No. 6,139,177 ("Venkatraman"). Claims 85, 110, 135 and 160 were rejected 35 U.S.C. § 103(a) as being unpatentable over Schein in view of Venkatraman and further in view of Levine U.S. Patent No. 5,988,078 ("Levine"). Claims 87, 112, 137 and 162 were rejected 35 U.S.C. § 103(a) as being unpatentable over Schein in view of Venkatraman and further in view of Shane U.S. Patent No. 5,793,972 ("Shane").

Reply to the § 112, first paragraph Rejection

The Examiner rejected claims 156-180 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner contends that applicants' specification lacks any teaching of a machine-readable medium capable of comprising machine program logic recorded thereon. Applicants respectfully traverse the Examiner's rejection.

Applicants have amended claims 156-180 to recite a computer readable medium comprising a computer program recorded thereon. Support for claims 156-180 may be found, for example, in paragraph [0072] of applicants' specification, which indicates that "the particular hardware system used [provides] television program guide services and features to user over the Internet in the form of multiple web pages." Applicants respectfully submit that it is inherent, from this and other passages describing the implementation of a program guide on a multimedia system, that computer readable medium comprising a computer program recorded thereon is provided. Accordingly applicants respectfully request that the Examiner's rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

Reply to the § 101 Rejection

The Examiner rejected claims 156-180 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In response, applicants have amended claims 156-180 to more particularly define the claimed invention. As amended, claims 156-180 recite a computer readable medium comprising a computer program recorded thereon. Applicants respectfully submit that, as amended, claims 156-180 are directed to statutory subject matter.

Accordingly, applicants respectfully submit that claims 156-180 comply with 35 U.S.C. § 101, and request that the Examiner's rejection be withdrawn.

Reply to the §§ 103 Rejections

Claims 81-84, 86, 88-109, 111, 113-134, 136, 138-159, 161 and 163-180 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schein in view of Venkatraman.

Claims 85, 110, 135 and 160 were rejected 35 U.S.C. § 103(a) as being unpatentable over Schein in view of Venkatraman and further in view of Levine. Claims 87, 112, 137 and 162 were rejected 35 U.S.C. § 103(a) as being unpatentable over Schein in view of Venkatraman and further in view of Shane.

Applicants respectfully traverse the Examiner's rejection.

Applicants have amended claims 81, 106, 131 and 156 to more particularly define the claimed invention. Applicants' claim amendments introduce no new matter and are fully supported by the originally filed specification (e.g., at ¶¶ 0081-0083).

Applicants' claimed invention is directed to a method, systems and computer-readable medium for providing an Internet television program guide. The system may receive an e-mail address from the user via a registration page to customize the information provided to the user, and receive

television listings provided by a computer system. The system may generate and display a web page of selectable program listings, and provide a program information page in response to a user selection of a selectable program listing.

In the Office Action, the Examiner correctly concedes that "Schein fails to specifically teach receiving an e-mail address provided by the user via a registration web page generated by the web server," and seeks to make up for this deficiency with Venkatraman.

First, Venkatraman itself strongly suggests that a person of ordinary skill would not have been lead to applicants' novel and nonobvious Internet television program guide to which users register to customize the information provided to the user. Specifically, FIG. 6 of Venkatraman describes a registration web page in which events are identified (e.g., EVENT_1 through EVENT_N) and input fields for e-mail addresses are associated with each identified event. The user may then indicate an interest in an identified event by entering an e-mail address in the associated input field. This approach has nothing to do with registering for an Internet television program guide to customize the information provided to the user. Instead, it merely is a means for a user to request notices for particular events that happens to be via a web page. Although

Venkatraman uses the term "register," it is clear from applicant's specification and claims that the term "register" has a meaning and a technical aspect that far surpasses the limited meaning and technical aspect that Venkatraman associates with the term.

In addition, the Office Action fails to articulate a legally sufficient rationale for rejecting the claims based on obviousness under 35 U.S.C. § 103(a). The Office Action does not specify which of the rationales set forth in the Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in view of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* is relied upon to support the rejection (72 FR 57526). Instead, the Office Action simply alleges that it would be obvious to combine Schein and Venkatraman "in order to receive messages specifying predetermined events associated with the user device" (Office Action, pp. 4-5). But this is nothing more than a statement as to what may be an advantage *if* one were to combine the teachings of the references - the Examiner has simply stated that the teaching of Venkatraman is useful. This does not provide the required articulated reasoning as to *why* a person of ordinary skill would combine the teachings of these references or why the claimed invention would be obvious in view of the references.

Indeed, applicants respectfully submit that this rejection is an example of the impermissible use of the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fitch, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). Thus, a prima facie case of obviousness has not been established.

Thus, applicants submit that there is no basis in Schein or Venkatraman, or otherwise, to combine the teachings of the references to result in applicants' claimed invention. As noted above, such a combination would result only from the application of inappropriate hindsight reconstruction.

In addition, neither Levine nor Shane makes up for the deficiencies of Schein and Venkatraman. Accordingly, applicants respectfully submit that claims 81-180 are patentable over Schein, Venktraman, Levine and Shane, whether taken alone or in combination, and respectfully request that the Examiner's rejection be withdrawn.

Conclusion

In light of the foregoing, applicants respectfully submit that this application is in condition for allowance. Prompt reconsideration and allowance are respectfully requested.

Respectfully submitted,

/ Paul E. Leblond /

Paul E. Leblond
Reg. No. 58,397
Agent for Applicants and Assignee
Ropes & Gray LLP
Customer No. 75563
525 University Avenue
Palo Alto, California 94301
Tel.: (650) 617-4000